

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Application No.	10/575,904	Examiner:	Robert C. WATSON
First Inventor:	Keitaro YONEZAWA	Art Group Unit:	3723
Filed:	April 14, 2006	Confirmation No.:	5549
Atty. Docket No.	YONE3024/JJC/PMB	Customer No.:	23364
For:	POSITIONING APPARATUS AND CLAMPING SYSTEM HAVING THE SAME		

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**REMARKS ACCOMPANYING
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

SIR:

Applicants respectfully request that a Pre-Appeal Brief Conference be initiated in accordance with the extension of the pilot program outlined in the Official Gazette notice of February 7, 2006.

These remarks and the request for the Pre-Appeal Brief Conference are concurrently filed with a Notice of Appeal in the above-identified application, and the appropriate fee for a one month extension of time.

For the reasons discussed below, the current rejection of claims 1-3, 7-11, and 17-19 under 35 U.S.C. § 112, second paragraph, and the current rejection of claim 1, from which the remaining pending claims depend, under 35 U.S.C. § 103(a) suffer from clear factual and legal deficiencies, and thus Applicants respectfully request that the application be allowed on the existing claims.

REJECTION OF CLAIMS 1-3, 7-11, and 17-19 UNDER 35 U.S.C. § 112, 2ND

PARAGRAPH

Claims 1-3, 7-11, and 17-19 are rejected under 35 U.S.C. § 112, second paragraph, since the phrase “orthogonal to the opposed direction” (as recited in claim 1, from which the remaining pending claims depend) is not understood.

As discussed in detail on pages 2 and 3 of the response filed on September 29, 2008, a person having ordinary skill in the art would understand the phrase “orthogonal to the opposed direction” to refer to a first radial direction that is oriented substantially orthogonal to (or at substantially right angles to) the opposed direction, which is clearly defined as the direction across which the plurality of slide portions are opposed to each other.

Accordingly, since a person having ordinary skill in the art would understand the meaning of the phrase “orthogonal to the opposed direction,” there are clear factual and legal errors with respect to the rejection of claim 1, from which the remaining pending claims depend, and withdrawal of this rejection, and allowance of the application on the existing claims is respectfully requested.

REJECTION OF CLAIM 1 UNDER 35 U.S.C. § 103(a)

Claim 1, from which the remaining pending claims depend, is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. publication no. 2003/0160374 (*Yonezawa*) in view of U.S. patent no. 5,427,349 (*Obrecht*).

A. Factual Deficiency in Rejection

It is respectfully submitted that there is a clear factual deficiency in the rejection of claim 1, from which the remaining claims depend.

In particular, it is respectfully submitted that the proposed combination of the of the *Yonezawa* publication and the *Obrecht* patent fails to disclose at least a second pressing member that is diametrically expandable and contractible or a plurality of slide portions arranged across the plug member in an opposed direction and movable in a first radial direction that is substantially orthogonal to the opposed direction, all as required by pending claim 1.

As detailed on pages 4-6 of the response filed September 29, 2008, and on page 9 of the response filed June 23, 2008, the *Yonezawa* publication fails to disclose at least a second pressing member that is diametrically expandable and contractible or a plurality of slide portions arranged across the plug member in an opposed direction and movable in a first radial direction that is substantially orthogonal to the opposed direction, all as required by pending claim 1.

As further detailed on pages 6-8 of the response filed September 29, 2008, and on pages 10-11 of the response filed June 23, 2008, the *Obrecht* patent fails to disclose at least a second pressing member that is diametrically expandable and contractible or a plurality of slide portions arranged across the plug member in an opposed direction and movable in a first radial direction that is substantially orthogonal to the opposed direction, all as required by pending claim 1.

Therefore, there is a clear factual error in the rejection of claim 1 on the basis that the proposed combination of the *Yonezawa* publication and the *Obrecht* patent fails to disclose at least a second pressing member that is diametrically expandable and contractible or a plurality of slide portions arranged across the plug member in an opposed direction and movable in a first radial direction that is substantially orthogonal to the opposed direction, all as required by pending claim 1.

Since there is a clear factual error in the rejection of claim 1, from which the remaining claims depend, a *prima facie* case of obviousness with respect to claim 1 cannot be established, and withdrawal of this rejection, and allowance of the application on the existing claims is respectfully requested.

B. Legal Deficiency in Rejection

It is respectfully submitted that there is a clear legal deficiency in the rejection of claim 1, from which the remaining claims depend.

In particular, it is respectfully submitted that a person having ordinary skill in the art would not have combined the features of the *Yonezawa* publication and the *Obrecht* patent.

In particular, since the proposed combination of the *Yonezawa* publication and the *Obrecht* patent would destroy the clamping function of the device of the

Yonezawa publication, for the reasons discussed in detail on page 7 of the response filed September 29, 2008, and on pages 10-11 of the response filed June 23, 2008 a person having ordinary skill in the art would not have altered the structure of the *Yonezawa* publication with the structure of the *Obrecht* patent in the manner proposed.

Therefore, there is a clear legal error in the rejection of claim 1 on the basis that a person having ordinary skill in the art would not have combined the features of the *Yonezawa* publication and the *Obrecht* patent in the manner as required by pending claim 1, since such a proposed combination would destroy the clamping function of the device of the *Yonezawa* publication.

Since there is a clear legal error in the rejection of claim 1, from which the remaining claims depend, a *prima facie* case of obviousness with respect to claim 1 cannot be established, and withdrawal of this rejection, and allowance of the application on the existing claims is respectfully requested.

CONCLUSION

Based upon the clear factual and legal deficiencies in the above-noted rejections, Applicants respectfully request that the application be allowed on the existing claims.

BACON & THOMAS, PLLC
625 Slaters Lane, Fourth Floor
Alexandria, Virginia 22314-1176
Phone: (703) 683-0500
Facsimile: (703) 683-1080

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Respectfully submitted,

/Patrick M. Buechner, Reg. #57,504/

PATRICK M. BUECHNER
Attorney for Applicants
Registration No. 57,504